REMARKS

In the Office Action, the Examiner rejected claims 1-15 and 21-24. Specifically, the Examiner rejected claims 1-8, 12-13 and 21-22 under 35 U.S.C. § 102(b) as anticipated by Danielson et al. (U.S. Patent No. 5,850,358). The Examiner also rejected claims 9-11, 14, 23 and 24 under 35 U.S.C. § 103(a) as unpatentable over Danielson et al. Finally, the Examiner rejected claim 15 under 35 U.S.C. § 103(a) as unpatentable over Danielson et al. in view of Dodd (U.S. Patent No. 6,127,949). By this paper, Applicant amended claim 13 to correct a clerical error. In view of the following remarks, the Applicant respectfully requests allowance of all pending claims.

Claim Rejections Under 35 U.S.C. § 102

As set forth above, the Examiner rejected claims 1-8, 12, 13, 21, and 22 under 35 U.S.C. § 102(b) as anticipated by Danielson et al. The Applicant respectfully traverses these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

Claims

The present application relates to a data entry device that allows a user to *enter* two or more *data selections* from a *single key* using a *single stroke*. Accordingly, independent claim 1 recites a data entry device comprising "a *key* having a *first data entry value* associated with *depressing the key*; the key having *one or more additional discrete data entry values*, each of the one or more additional discrete data entry values being associated with *deflecting the key* in a predetermined direction." Similarly, independent claim 12 recites "a plurality of keys, each key having a *first data entry value* associated with *depressing the key*, each key having *one or more additional discrete data entry values* associated with *deflecting the key*." Further, independent claim 21 recites "defining a *first data zone* that is actuated when the *hardware key is depressed* and at least one *additional data zone* corresponding to the at least one *additional predetermined direction*."

Additionally, independent claims 1, 12 and 21 each recite *user readable indications* of the multiple data entry values associated with each key. Specifically, claim 1 recites "the key having a *user readable indication* for the first data entry value and each of the one or more additional discrete data entry values." Similarly, claim 12 recites "each key having a *readable indication* of the first data entry value and each of the one or more additional discrete data entry values." Likewise, claim 21 recites "the hardware key having a *user readable indication* of the first data entry value."

Omitted Claim Features

In the present case, Danielson et al. cannot anticipate the instant claims, because

Danielson et al. do not disclose all of the elements set forth in those claims. In fact,

Danielson et al. merely disclose four *cursor movement* keys arranged in a *direction-*

coordinated cluster (i.e., left, right, up, and down). Col. 7, lines 2-3. Danielson et al. do not

disclose multiple *data entry* values associated with depressing or deflecting a key, nor do they

disclose each key having a *user readable indication* of the data entry values.

First, the *cursor movement* keys of Danielson et al. merely operate to move a cursor

on a screen to "manipulate various alpha-numeric menu displays and prompts." Col. 7, lines

4-5. In other words, the cursor keys operate much like the joystick described in the present

Application's Description of Prior Art, which allows a user to "control a screen display."

Application, page 1, paragraph 2. There is no "data entry value" associated with the cursor

keys of the Danielson et al. reference. In fact, the cursor keys must operate in conjunction

with other keys in order to activate data prompts. *See* Danielson et al., col. 7, lines 2-8 and

37-42. In other words, the cursor keys of Danielson et al. operate only for cursor movement

to a desired screen location, while other separate keys actually perform a function at that

screen location. The cursor keys alone cannot even activate data prompts, much less

associate with "data entry values" at multiple portions of the keys. Accordingly, the

Danielson et al. reference does not disclose each and every element of the claimed invention.

Second, the Danielson et al. reference does not disclose *user readable indications*

corresponding to data entry values at various portions of the cursor keys. In sharp contrast,

Danielson et al. merely disclose cursor keys arranged in a direction-coordinated cluster

having directional arrows (i.e., left, right, up, and down). *See* col. 7, lines 2-3, and fig. 1. As

discussed previously, the cursor keys do not have associated data entry values; much less

readable indications corresponding to such data entry values. Accordingly, the Danielson et

al. reference does not disclose each and every element of the instant claims.

Request for Withdrawal

Because independent claims 1, 12 and 21 each recite elements missing from the

Danielson et al. reference, Applicant stresses that Danielson et al. cannot anticipate claims 1,

12, and 21 and the claims depending therefrom. Accordingly, the Applicant respectfully

requests withdrawal of the rejection of claims 1-8, 12, 13, 21, and 22 under Section 102.

The Rejections Under 35 U.S.C. § 103

As set forth above, the Examiner rejected claims 9-11, 14, 23 and 24 under 35 U.S.C.

§ 103(a) as obvious based on a modification of the Daniel et al. reference. Additionally, the

Examiner rejected claim 15 under 35 U.S.C. § 103(a) based on Danielson et al. as modified in

view of Dodd. Applicant respectfully traverses these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner.

Ex parte Wolters and Kuypers, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot

be established by combining the teachings of the prior art to produce the claimed invention

absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc.*

v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Accordingly, to establish a *prima facie* case, the Examiner must not only show that the

combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Omitted Claim Features

In the present case, neither the Danielson et al. reference as modified by the Examiner nor the combination of Danielson et al. in view of Dodd can render the Applicant's claims obvious under Section 103. The cited references do not include all of the elements recited in the independent claims. As discussed in detail above, independent claims 1, 12 and 21 each recite multiple data entry values associated with depressing or deflecting a key and, also, a user readable indication of the data entry values. In sharp contrast, Danielson et al. teaches cursor movement keys, which only serve to move a screen cursor. Thus, Danielson et al. clearly omit certain features recited in the independent claims 1, 12, and 21. Applicant stresses that the Dodd reference does not obviate these deficiencies. In fact, the Examiner cited Dodd only for its alleged disclosure of features recited in the dependent claims.

Request for Withdrawal

In view of these deficiencies, Applicant respectfully requests withdrawal of the rejection of claims 9-11, 14, 15, and 23-24 under 35 U.S.C. § 103.

Conclusion

In view of the amendments and remarks set forth above, the Applicant respectfully requests withdrawal of all of the Examiner's rejections and objections. Furthermore, the Applicant asserts that an indication of the allowability of claims 1-15 and 21-24 is appropriate. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: February 25, 2004

Tait R. Swanson
Registration No. 48,226
(281) 970-4545

CORRESPONDENCE ADDRESS:
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Department, M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400